

## **REMARKS**

Applicants would like to thank the Examiner for the careful consideration given to the present application. The present application currently has claims 1-15 and 25-26 pending. The application has been carefully reviewed in light of the Office Action. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below. Reconsideration of this application is hereby requested.

### **Claim Objections**

The Examiner has objected to claims 1-9 because in claim 1, line 2, the phrase “is-coated” should apparently be “is coated.” Applicant has, accordingly, provided a copy of all of the currently pending claims, with current status identifiers, to address the informality cited by the Examiner.

### **Claim Rejections – 35 U.S.C. 112**

The Examiner has rejected claims 8 and 25 under 35 U.S.C. 112, second paragraph as being indefinite. The Examiner states that claims 8 and 25 are indefinite because the second surface is not coated with the first colored coating composition, but rather, the second surface is coated with a second colored composition that is the same as the first colored coating composition.

In Applicants specification, page 10, lines 1-17, it is stated that the second surface may have a layer of a second colored coating composition (lines 1-2), or, alternatively, instead of being composed of a second colored composition, the second surface may be composed of the first colored coating composition. Thus, opposing sides of the color card may be substantially identical.

In light of the foregoing, Applicants do not believe that claims 8 and 25 are indefinite and respectfully ask that the Examiner remove the rejection.

### **Claim Rejections – 35 U.S.C. 103**

The Examiner has rejected claims 1-4 and 10-14 under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification in view of Teter et al. (U.S. Patent No. 6,112,665). Applicants traverse this rejection for the following reasons. To establish a *prima facie* case of obviousness, one criterion that must be met is that there must be some suggestion or motivation to combine reference teachings. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner states that Applicants admitted prior art discloses the idea of covering a color card with a single color but does not disclose the idea of placing perforations on the card to form a detachable paint chip. Further, the Examiner states that Teter et al. teaches the idea of placing perforations within a colored section in order to allow the perforated area to be removed. The Examiner has combined Teter et al. in combination with Applicants prior art teaching, and has asserted that claims 1-4 and 10-14 are obvious in light of the combined references.

Applicants respectfully submit that there is absolutely no suggestion or motivation to combine the two teachings that the Examiner has used to make the instant rejection. As such, independent claims 1 and 10, and accordingly all claims depending therefrom, are not obvious. With respect to the Examiner's combination of Applicants prior art teaching and Teter et al., there is no suggestion in either reference, and more importantly, there is certainly no suggestion in Teter et al., to combine the references to arrive at placing perforations on a color card with a single color in order to form a detachable paint chip. Absent any suggestion or motivation to combine, it cannot be obvious to combine the references. Furthermore, the references actually teach away from any such combination.

The Teter et al. reference specifically and solely teaches the use of a color card with a plurality of color swatches. In fact, Teter et al. is the type of color card that Applicant has referenced as being undesirable – a conventional color card with a multitude of colors. The set of perforations within the colored area, as taught by Teter et al. are part of a larger swatch card of multiple colors. Teter et al. in no way suggests the use of perforations with a single-color color card. Throughout the Teter et al. reference, there is mention that the color card includes many colors. Column 4, line 43 *et seq.* states that the stippling in Figs. 4 and 5, i.e., the same figures

that the Examiner has used to make the instant rejection, is used to indicate different printed colors. Additionally, the Teter et al. reference is replete with references to more than one color used on the color card. In Col. 4, lines 48-50, of the Teter et al. reference it is taught that the colors of the swatches may be related or totally independent from one another. There is no suggestion to include only a single color on the Teter et al. color card.

Applicants have specifically stated that there are many deficiencies with the use of conventional color cards that exhibit numerous colors (see Specification page 1, line 28 *et seq.*). One deficiency that Applicants have referenced is that the human eye tends to blend colors together when the colors are presented such as they are on a conventional color card of multiple colors. Additionally, the intensity that is imparted to a specific color is not as apparent on a conventional color card as would be on a larger surface, such as a single-color color card. Accordingly, there is no suggestion or motivation to combine a reference that teaches a multiple-color color card, such as Teter et al. with a teaching of a single-color color card.

Furthermore, the distinctions pointed out between single-color and multiple-color color cards, and Applicants teaching of the undesirability of using a multiple-color color card, in fact teach away from any combination of a single-color color card with a multiple-color color card reference.

The functionality of the single-color color card and the multiple-color color card is completely different and the teachings of the contrasting cards are not compatible for use with one another. Applicants prior art teaching, as discussed above, shows that a single-color card is not consistent with and is contrary to the purposes and functionality of a multiple-color color card insomuch that a multiple-color color card has many deficiencies that are addressed through the use of a single-color color card. As such, Applicants prior art teaching cannot properly be combined with Teter et al.

In addition to the above reasons for patentability of the instant claims, the Teter et al. reference does not contemplate that the color on the swatches are formulated to have a dried color that is substantially similar to dried color of a commercially available paint composition. The Teter et al. patent contemplates that the blank swatches are run through a color printer or photocopier to provide for a color on the swatches. There is no motivation to use Teter et al. to exhibit colors similar to commercially available paint colors. In fact, the reference contemplates the ability to make swatches for colors that represent “spot” colors and textiles. Additionally, the

swatches may be used to record the color samples that pertain to printing projects or advertising campaigns. Accordingly, there is no suggestion to combine the Teter et al. reference with the prior art teaching in Applicants specification, which discloses a single-color color card for the display of paint. As such, independent claims 1 and 10 are not obvious, and all claims depending from claims 1 and 10 are not obvious.

With respect to claim 2, Applicants also traverse this rejection. Applicants submit that the Examiner has not established a *prima facie* case of obviousness with respect to claim 1. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending from the independent claim is also nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no basis for an obviousness rejection of claim 2 in light of the failure of the references to provide any suggestion or motivation to be combined.

With respect to claims 3 and 13, Applicants traverse this rejection. The Examiner has stated that Applicants prior art teaching discloses the idea of making a conventional color card rectangular but does not disclose the shape of a single-color color card. Applicants claims 3 and 13 do not address the shape of the color card, but rather, claim 3 and 13 claim a chip section that is generally square. There is no suggestion or motivation from Teter et al. to provide for a generally square chip section. In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). Throughout the Teter et al. reference, the perforated sections are always depicted as circular holes. The holes, particularly the hole provided for in the corner of the Teter template, to accept a fastener. The failure to provide any teachings to for a generally square chip sections, in addition to the fact that the independent claims are not obvious, support a finding that claims 3 and 13 are also not obvious.

Applicants also traverse the rejection of claim 11. With respect to claim 11, Applicants believe that neither the teachings of the prior art as stated in Applicants specification nor the Teter et al. reference disclose the element of a tear line that has ends that are separated by a space in which the paint color card is not perforated. Again, in order to meeting a finding of *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The Examiner has not provided any support for the rejection of claim 11 in the form of prior art teachings for the claim limitations. Applicants prior art discussion in the specification does not provide for the elements listed in claim 11. Moreover, the Teter et al.

reference does not disclose the element of a tear line that has ends separated by a space in which the color card is not perforated. The Teter et al. reference, in fact, discloses and contemplates continuous perforated areas, as discussed throughout the Teter et al. specification, and as illustrated in Fig. 1 of the Teter et al. reference. Throughout the Teter et al. reference, the perforated sections are always depicted as circular holes. There is no section of the perforated area that has a space of non-perforation. Therefore, it would be extremely difficult, if not impossible, to fold over the perforated section of a circular hole to create an opening based on the teachings of the Teter reference to arrive at Applicants claim 11. Accordingly, claim 11 is not obvious.

The Examiner has rejected claims 5-7 and 15 under 35 U.S.C. 103(a) as being unpatentable over Applicants admitted prior art in view of Teter et al. and further in view of Day et al. Applicants traverse this rejection. Applicants prior art discussion as provided in the specification of the subject application and the Teter et al. reference cannot properly be combined because of the lack of suggestion or motivation to combine them. Applicants have provided arguments in favor of this position with respect to independent claims 1 and 10, above. As such, dependent claims 5-7 and 15 also cannot be obvious.

With respect to claim 7, Applicants have amended claim 7 to state that the indicia is printed on a second surface of the paint color card. The element of indicia printed on a second surface of the paint color card is not found in the prior art references cited by the Examiner and therefore, claim 7 is not obvious.

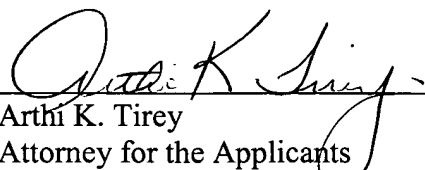
The Examiner has rejected claims 8 and 25 under 35 U.S.C. 103(a) as being unpatentable over Applicants prior art discussion in the specification in view of Teter et al. and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113). Applicants traverse this rejection for the following reasons. As Applicants have stated above, Applicants prior art discussion and Teter et al. are not properly combinable because there is no suggestion or motivation to combine the references. As such, independent claim 1 is not obvious and claim 8, depending from claim 1, is also not obvious. Applicants also believe that claim 10 is not obvious for reasons set forth above, and as such, claim 25 is also not obvious.

The Examiner has rejected claims 9 and 26 under 35 U.S.C. 103(a) as being unpatentable over Applicants prior art discussion in the specification in view of Teter et al. as applied to claim 1 and 10 and further in view of Goldsholl. Applicants traverse this rejection for the following reasons. As Applicants have stated above, Applicants prior art discussion and Teter et al. are not properly combinable because there is no suggestion or motivation to combine the references. As such, independent claims 1 and 10 are not obvious and claims 9 and 26, depending from claims 1 and 10 respectively, are also not obvious.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If the Examiner has any questions with respect to the foregoing, he is invited to contact the undersigned. Applicants would like to again thank the Examiner for his review of the subject application.

Respectfully submitted,

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